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Customer No. 27061
Confirmation No. 5745Patent
Attorney Docket No. GEMS8081.023

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Durbin et al.
Serial No. : 09/681,017
Filed : November 22, 2000
For : METHOD AND SYSTEM TO REMOTELY ENABLE
SOFTWARE-BASED OPTIONS FOR A TRIAL PERIOD
Group Art No. : 3621
Examiner : Calvin Loyd Hewitt II

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

- Mailing
- ☐ deposited with the US Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
- 37 CFR 1.8(a) 37 CFR 1.10
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- Transmission
- ☒ transmitted by facsimile to Fax No.: 571-273-8300 addressed to Director Wynn Coggins at the Patent and Trademark Office.
- Date: May 12, 2008 /Gregory V. Madden/
Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND
RULES OF 37 C.F.R. §1.131 and 37 C.F.R. §1.48

Dear Sir:

In response to the Decision on Petition mailed October 12, 2007, Applicant submits this Petition under 37 C.F.R. § 1.183. Applicant respectfully requests suspension of the requirements of 37 C.F.R. § 1.131 and 37 C.F.R. § 1.48 in order to proceed with a renewed Antedating Declaration without the signatures of joint inventors Winnie Durbin, Karamjeet Singh, and Kun Zhang.

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REMARKS

Applicant hereby petitions for suspension of the requirement of 37 C.F.R. §1.131 that all joint inventors must participate in a Declaration establishing invention of the claimed subject matter prior to the effective date of a cited reference. Applicant also hereby petitions for suspension of the requirement of 37 C.F.R. 1.48 that all joint inventors must participate in a Declaration to correct inventorship. Joint inventors Winnie Durbin, Karamjeet "KJ" Singh, and Kun Zhang are no longer employed by the Assignee of the present application. Joint inventors Durbin and Singh have not agreed to sign an antedating declaration, and joint inventor Zhang has been unreachable. As is set forth in a concurrently-filed Petition to Correct Inventorship under 37 C.F.R. § 1.48, four (4) inventors were mistakenly omitted from the application as originally filed. These four inventors (David T. Mehrling, Thomas L. Lamoureux, Hubert A. Zettel, and Timothy D. Butler) have agreed to sign the antedating declaration under 37 C.F.R. §1.131.

As a preliminary matter, a Decision on Petition mailed October 12, 2007 ("the Decision") granted Applicant's previous renewed petition of June 12, 2007 for suspension of the requirement of 37 C.F.R. §1.131 that all joint inventors must participate in a Declaration establishing invention of the claimed subject matter prior to the effective date of a cited reference. The Decision stated that

"Under the facts presented, it is agreed that justice requires waiver of the rules to the extent that they require Karamjeet Singh and Kun Zhang to declare. However, the favorable decision herein does not relieve applicants from their burden to establish that the invention was completed before the date of the reference and that the claimed invention was the product of the joint inventors."

Decision, October 12, 2007, pg. 1. Prior to receiving the Decision, Applicant had filed an antedating declaration under 37 C.F.R. §1.131 on March 26, 2007 containing only the signature of joint inventor Winnie Durbin. In view of the subsequent Decision of October 12, 2007, Applicant believes that the antedating declaration under 37 C.F.R. §1.131 was acceptable.

A Final Office Action was subsequently mailed January 11, 2008, wherein the Examiner stated that

"Applicant's Affidavit filed on 26 March 2007 is not sufficient to overcome the rejection to claims 1-26 as the Applicant has not established diligence (37 CFR 1.131)."

Final Office Action, January 11, 2008, pg. 2. In order to obtain the evidence required to establish diligence, Applicant attempted to contact joint inventor Winnie Durbin. However, an email correspondence to joint inventor Durbin's last known email address was returned as

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undeliverable. Attached hereto as Exhibit A is a copy of the returned email. Further attempts to contact Ms. Durbin were unsuccessful, and it was confirmed by Ms. Durbin's spouse that she was no longer employed by the assignee and did not wish to be contacted. Attached hereto as Exhibit B is a copy of the email correspondences with Mr. Phillip Durbin, joint inventor Winnie Durbin's spouse. Thus, despite numerous efforts, the undersigned was unable to obtain the contact information and cooperation of Ms. Durbin.

During the efforts to contact Ms. Durbin and to obtain the evidence required to establish diligence in compliance 37 C.F.R. §1.131, it was further brought to the undersigned's attention that four inventors were incorrectly omitted from the application as originally filed. Thus, a Petition to Correct Inventorship under 37 C.F.R. § 1.48 is being filed concurrently herewith, effectively adding joint inventors David T. Mehring, Thomas L. Lamoureux, Hubert A. Zettel, and Timothy D. Butler. Mr. Mehring, Mr. Lamoureux, Mr. Zettel, and Mr. Butler have, as joint inventors, have agreed to sign the declaration under 37 C.F.R. § 1.131.

Accordingly, Applicant believes that it should not be prejudiced by the lack of signatures from a missing former employee and two uncooperative former employees, especially considering Applicant is able to supply the signatures of four additional joint inventors to support the declarations under 37 C.F.R. § 1.131 and 37 C.F.R. § 1.48.

Applicant therefore respectfully requests the suspension of the rules of §1.131 and § 1.48 requiring signatures from all joint inventors on the declarations. Applicant hereby authorizes charging of Deposit Account No. 50-2402 for the fee of \$400.00 under 37 C.F.R. 1.17(f).

Applicant appreciates the consideration of this Petition and invites the Office of Petitions to contact the undersigned, should any matters be considered unresolved.

Respectfully submitted,

/Timothy J. Ziolkowski/

Timothy J. Ziolkowski
Registration No. 38,368
Phone: 262-268-8181
tjz@zpspatents.com

Dated: May 12, 2008
Attorney Docket No.: GEMS8081.023

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
136 S. Wisconsin St.
Port Washington, WI 53074
262-268-8100

EXHIBIT A

[REDACTED]

From: System Administrator [postmaster@gecapital.com]
Sent: Thursday, February 14, 2008 4:30 PM
To: [REDACTED]
Subject: Undeliverable: Patent Application for Remotely Enabling Software Options / Flex-Trial (15-SV-5377 / 8081.023)
Attachments: Patent Application for Remotely Enabling Software Options / Flex-Trial (15-SV-5377 / 8081.023)

Your message

To: winnie.durbin@med.ge.com
Subject: Patent Application for Remotely Enabling Software Options / Flex-Trial (15-SV-5377 / 8081.023)
Sent: Thu, 14 Feb 2008 17:18:10 -0500

did not reach the following recipient(s):

WINNIE.DURBIN@MED.GE.COM on Thu, 14 Feb 2008 17:30:16 -0500

The recipient name is not recognized

The MTS-ID of the original message is: c=us;a=mark400;p=ge;l=IMC0802142230181JVBHZ
MSEXCH:IMS:GE:ALPHARETTA:ALP01SSBHMAILGE 0 (000C05A6) Unknown Recipient

EXHIBIT B

[REDACTED]

From: Tim Ziolkowski
Sent: Monday, March 10, 2008 2:23 PM
To: Greg Madden
Subject: FW: Status 8081.023

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[REDACTED]

From: Durbin, Phillip L (GE Healthcare) [mailto:Phillip.Durbin@med.ge.com]
Sent: Monday, March 10, 2008 12:50 PM
To: Tim Ziolkowski
Subject: RE: Status 8081.023

Sorry, I was not involved with any of her projects.

Phil

From: Tim Ziolkowski [mailto:tjz@zpspatents.com]
Sent: Thursday, March 06, 2008 7:29 PM
To: Durbin, Phillip L (GE Healthcare)
Subject: RE: Status 8081.023

Phil,

I wasn't sure about Bill's first email to you. He seemed to imply that you could help. Were you involved in the same projects as Winnie back in 99-01?

Tim

From: Durbin, Phillip L (GE Healthcare) [mailto:Phillip.Durbin@med.ge.com]
Sent: Thursday, March 06, 2008 7:17 PM
To: Tim Ziolkowski
Subject: RE: Status 8081.023

Tim,

Thanks in advance for your understanding, however, at this time it is best to proceed with the fact that you have exhausted all efforts to obtain her assistance.

Phil

From: Tim Ziolkowski [mailto:tjz@zpspatents.com]
Sent: Thursday, March 06, 2008 6:42 PM
To: Durbin, Phillip L (GE Healthcare)
Cc: Mehring, David T (GE Healthcare); Frowein, Rick (GE Healthcare); Kryger, William T (GE Healthcare)
Subject: FW: Status 8081.023

Phil,

EXHIBIT B

Does that also mean that she will not contact me? I just want to make sure that I have exhausted all efforts at obtaining her assistance. It just seems odd because she was so very helpful 6 mos ago, and we don't really need that much of her time.

Thanks,
Tim

From: Durbin, Phillip L (GE Healthcare) [mailto:Phillip.Durbin@med.ge.com]
Sent: Thursday, March 06, 2008 6:34 PM
To: Tim Ziolkowski
Subject: RE: Status 8081.023

Hi Tim

Winnie has moved on to another company and she prefers that I not forward any contact information.

Thank you,

Phil

From: Tim Ziolkowski [mailto:tjz@zpspatents.com]
Sent: Thursday, March 06, 2008 6:10 PM
To: Kryger, William T (GE Healthcare); Durbin, Phillip L (GE Healthcare)
Cc: Mehring, David T (GE Healthcare); Frowein, Rick (GE Healthcare); Greg Madden
Subject: RE: Status 8081.023

Hi Philip – can you please send me Winnie's contact info or have her contact me?
Thanks,
Tim

Timothy J. Ziolkowski
Intellectual Property Law
ZPS Group, SC
Imagine. Invent. Protect.

136 S. Wisconsin St.
Port Washington WI 53074
262-268-8100 general line
262.268.8181 direct line
262.268.8185 fax line
Email: tjz@zpspatents.com
Site: www.zpspatents.com

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EXHIBIT B

From: Kryger, William T (GE Healthcare) [mailto:william.kryger@ge.com]
Sent: Thursday, March 06, 2008 2:08 PM
To: Durbin, Phillip L (GE Healthcare)
Cc: Mehring, David T (GE Healthcare); Tim Ziolkowski; Frowein, Rick (GE Healthcare)
Subject: RE: Status 8081.023

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Hi Phillip,

Per the email chain listed below, can you help in regard to prosecution of an application covering the subject matter of the identified disclosure (Winnie Durbin was co-inventor). We would appreciate any help that you give outside counsel - Tim Ziolkowski in this matter.

Best regards.

Bill Kryger
Patent Procurement Counsel
GE Healthcare
Ph: 262-548-4654
F: 262-521-6793
E: william.kryger@ge.com

3000 N. Grandview Blvd., SN-477
Waukesha, WI 53188

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From: Mehring, David T (GE Healthcare)
Sent: Thursday, March 06, 2008 2:01 PM
To: Tim Ziolkowski
Cc: Kryger, William T (GE Healthcare); Greg Madden
Subject: RE: Status 8081.023

Tim, I am currently swamped with a product release, which goes out next week. I am also out next week for training.. I will try to look at this when I return. Winnie's Husband does still work for HC - Phil Durbin, Phillip L (GE Healthcare)
Phillip.Durbin.med.ge.com

David Mehring
Manager, Service Solution Components
Global Services Technologies
GE Healthcare
Technologies

T 262 524 5152
C 262 424-5552
F 262 896 2790
D 8*579 5152
E David.Mehring@med.ge.com
<http://www.gehealthcare.com/>

From: Tim Ziolkowski [mailto:tz@zpspatents.com]
Sent: Wednesday, March 05, 2008 6:31 PM